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10/782,472	02/18/2004	Jonathan Dale	073338.0135 (02-53312 FLA	4871
5073	7590	09/04/2008	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			McCORMICK, GABRIELLE A	
			ART UNIT	PAPER NUMBER
			3629	
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			09/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/782,472

Applicant(s)

DALE, JONATHAN

Examiner

Gabrielle McCormick

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on July 24, 2008.
2. Claims 17-24 have been amended.
3. Claims 1-25 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
6. Claims 1, 9, 17 and 25 contain limitations requiring the determination of "whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements". The specification provides:
7. Pg. 2: For each of the identified service providers, the method communicates with the service provider to determine feature interfaces for interacting with the service provider, accesses at least one of the feature interfaces of the service provider to determine service descriptors describing a service provided by the service provider, and determines whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements. The method also ranks each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers.
8. Pg. 13: For example, for a particular materials supply request, description 44 may include a number of request specific descriptors indicating preferences, constraints, and other suitable types of information for interacting with and judging supply services.

9. Further, claims 1, 9, 17 and 25 contain limitations requiring "ranking each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers". The specification provides:
 10. Pg. 19-20: For example, the business function description may include specific criteria that must be satisfied in order for particular services 18 to be considered. If services 18 remain, organization agent 22 ranks the matching services 18 according to appropriate criteria at step 124 . For example, in the purchasing context, organization agent 22 may arrange various product bids based upon cost, delivery time, and other suitable criteria.
11. The specification does not provide any further detail as to how a service provide is deemed "satisfactory" or how ranking is accomplished. The disclosures of preferences and constraints appear to indicate that some factors may be weighed positively and others negatively in determining satisfaction and ranking, however, the specification does not provide the algorithms that would be used in such a case. Further, as preferences and constraints are assessed differently by different people or organizations, a plethora of choices exists that could comprise criteria for judging a supplier. Applicant's claims are directed to broad concepts defined by examples and generalities, with an infinite variety of possible evaluations of satisfaction and rankings to be assigned in an infinite variety of ways and used in an infinite variety of calculations. Applicant has not defined any means to determine a provider as "satisfactory" or to rank those that are satisfactory. Thus, the Examiner asserts that specification does not provide sufficient guidance and direction to one skilled in the art to make and use applicant's invention without undue experimentation.
12. Claim 9 additionally claims an "organization agent operable to...establish an organization database...". The specification does not provide a disclosure for how an "agent" establishes a database. As a result of the lack of direction provider by the inventor and lack of a working example, the disclosure would require undue experimentation and therefore does not satisfy the enablement requirement.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
15. Claim 9 discloses a system with "an organizational agent", however, it is unclear whether the organizational agent is operable to provide the communication, access, determination and ranking steps associated with the service providers. The system components or structure is not claimed such that one understands the structure required to carry out these steps. The operation of the organization agent is defined by method type steps rather than by structure. As a result, the claim purports to be both a system and a process and is therefore ambiguous. Claims 10-16 depend from claim 9 and are rejected.
16. Applicant's argument that the specification clearly describes "rank[ing] each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers" suffices to cure the clarity of claim scope regarding claims 1, 9, 17 and 25. The Examiner withdraws the rejections under the second paragraph of 35 USC 112 to claims 1, 9, 17 and 25.
17. As per claims 2, 10 and 18, Applicant's argument that "if", in the context of the claims, has the same meaning as "when" is satisfactory. The rejection is withdrawn.
18. As per claims 4, 12 and 20, the Examiner will understand the negotiation threshold to be compared with the variable service descriptors and not the modified deal parameters. Further, the Examiner will understand the step of "iteratively accessing" to be a repetition of a negotiation, therefore the previous requirement to specify an end to the negotiation is withdrawn.
19. Applicant argues that as claims 6, 14 and 20 are dependent from claims 1, 9 and 17, that an initial ranking of current service providers is produced. The Examiner disagrees. Claims 1, 9 and 17 are directed to ranking "satisfactory service providers", not "current service providers". Claims

6, 14 and 20 clearly differentiate "current service providers" from "satisfactory service providers". However, the Applicant is correct that the specification does not provide a step for ranking current service providers; therefore the rejection of the claims for omitting an essential step is withdrawn.

Claim Rejections - 35 USC § 101

20. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

21. Claims 1-25 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter.
18. Claims 1-25 are rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. "Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. **"Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation.** "Tangibility" may be evidenced by, but not limited to, a real or actual effect.
19. In the present case, the evaluation of provider satisfaction and ranking appears to be based on the subjective interpretation of the user. Applicant's claim language states that the evaluation of satisfaction is based on satisfying a portion of business function requirements where the specification further provides that preferences and constraints are used to judge supply services, therefore, there could be different results based on the subjective determination of the user. The ranking of the providers is vaguely based on the service descriptors (claims 1, 9, 17 and 25) and "criteria" (specification). Thus, the satisfaction of the providers and resulting ranking determined using this subjective analysis would render the applicant's invention as being incapable of providing concrete results as required by 35 U.S.C. 101 since it would be difficult for a person to repeat the analysis and determination of another based on the subjective subject matter without undue experimentation.

20. Claims 1-8 are method claims that recite process steps that are not tied to another statutory class, such as a particular apparatus. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972) and *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101. Claims 2-8 are rejected through their dependency to rejected claim 1.
22. 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof". Applicant's claims 9-16 are directed to a system, however, recite as part of the system "a plurality of service providers". As service providers encompass human beings, they are not a statutory class of subject matter and therefore are not patent eligible subject matter. "If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter." (MPEP; 2105). Applicant has argued that service providers does not encompass human beings and points to the specification at pg. 6; lines 14-17. The Examiner maintains that service providers can be understood to encompass human beings and cites pg. 9; line 25: "service providers 12 register their services 18 with one or more service registries 24." One of ordinary skill in the art would understand that a human being would perform the registration.
23. Applicant's amendment to claims 17-24 have overcome the previous rejection under 35 USC 101, however, the claims, as discussed above, remain under rejection.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. **Claims 1-7, 9-15, 17-23 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Das et al. (US Pub. No. 2003/0023499, hereafter referred to as "Das") in view of Vashistha et al. (US Pub. No. 2001/0051913, hereafter referred to as "Vashistha").

26. **Claims 1, 9, 17 and 25:** Das discloses

- *a plurality of business function requirements;* (P[0047]: "short or long term strategic purchasing policy rules")
- *accessing a service registry of a plurality of service providers;* (P[0065])
- *for each of the identified service providers:*
- *communicating with the service provider to determine feature interfaces for interacting with the service provider;* (P[0050]: "services" are identified, therefore, service providers comprise the vendors of P[0066])
- *accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider;* (P[0068] negotiations are conducted using the internal rules and parameters where price and time that a product is needed are factors that are negotiated, therefore, in order to negotiate around these factors, the service provider must at least have service descriptors that disclose pricing and availability. P[0050]: parameters, including price, quantity, delivery times and quality measures are used to negotiate the purchase from sellers, therefore, negotiation involves determining descriptors provided by the provider. P[0052]: vendors are compared based on price and quality, thus, price and quality are disclosed as descriptors.)

- *determining whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements; (P[0047]: rules include rank ordering for calculating tradeoffs among different product or vendor attributes and rank ordered lists of preferred vendors (i.e., satisfactory) and P[0052]).*
 - *ranking each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers. (P[0047]: rules include rank ordering for calculating tradeoffs among different product or vendor attributes (i.e., service descriptors) and rank ordered or weighted lists of preferred vendors.).*
27. Das does not explicitly disclose *establishing an organizational database maintaining at least one business function description comprising a business function indicator; using the business function indicator to identify a network address for each service provider each having a service indicator matching the business function indicator.*
28. Vashistha, however, discloses a registration module for buyers and providers that includes a buyer database. Buyer and supplier profiles are entered such that the outsourcing system can suitably match buyers and providers, therefore, it is obvious that a business function indicator is disclosed that enables identification of the provider. (P[0036]); the matching module uses data and criteria from buyers to match to data captured from providers so to identify only those providers meeting a minimum level of matching. (P[0038]: this discloses the functionality of determining a satisfactory level based on business function requirements where the provider is identified by the business function description. A service provider's network address is identified such that notification of qualified providers can be made via e-mail (P[0038]).
29. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an organizational database using business function indicators to identify a network address for each provider, as disclosed by Vashistha in the system disclosed by Das, for the motivation of providing a method that "enables buyers, i.e., companies that need IT projects and/or services implemented and completed, to obtain end-to-end knowledge and support to initiate, decide and implement IT projects and services with providers..." (Vashistha;

P[0029]). Das discloses the system and methodology for automatically making operational purchasing decisions in a data network using purchasing rules that evaluate possible vendors to identify a set of vendors from which the product or service may be obtained, with a final selection for purchase from one or more vendors using rules, information about the vendors and the results of negotiations. (Das; P[0013]). Therefore, both Vashistha and Das aim to accomplish the objective of matching buyers and providers using rule based decision making systems and methodologies, thus it is obvious to expand Das to include the features of Vashistha.

30. **Claims 2, 3, 5, 7, 10, 11, 13, 15, 18, 19, 21 and 23:** Das discloses parameters for negotiating the purchases from sellers using variable service descriptors, including price, quantity, allowable substitutions, order size and delivery times (P[0050]). Following the negotiations, controller 410 selects one or more of the potential vendors (P[0080]) and provides notification/authorization by transmitting purchase orders to the selected vendors. (P[0073]). Das does not disclose ranking based on the negotiations.
31. Vashistha, however, discloses ranking bids (P[0066]) following a discussion and bidding module which provides a mechanism for facilitating the collaboration between buyers and providers to obtain an improved understanding of the RFP. (P[0064]. Vashistha also discloses providing a qualified list of providers following scoring and ranking, thus providing a notification identifying the highest ranking provider. (P[0063]).
32. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included ranking prior to final selection, as disclosed by Vashistha, in the system of Das for the motivation of selecting a provider. Ranking is an old and well known form of aiding decision making and Das discloses that the selection may be based on the results of the negotiation, as well as other factors where the lowest price is not necessarily the basis for selection. (Das; P[0080]). By scoring and ranking, as disclosed by Vashistha, these other factors are accorded a role in the automated decision making process of Das.
33. **Claims 4, 12 and 20:** Das discloses a plurality of deal parameters and a negotiation threshold (i.e., "maximum acceptable price") (P[0047-0048]) and performing a negotiation via a "back-and-

- forth sequence of offers and counteroffers" where each counteroffer is compared to rules to determine acceptability. (P[0068]).
34. **Claims 6, 14 and 22:** Das discloses retrieving a list of known vendors and additionally querying a directory to find new vendors to add to the list (P[0065]). Vendors are then negotiated with (P[0068]) until a selection is made and a purchase order transmitted (P[0073]). Das does not disclose a highest ranking between current and satisfactory service providers.
35. Vashistha, however, discloses matching buyers to both providers the buyer currently uses and with a global network of providers where both buyers and providers are notified. (P[0038]). Vashistha further discloses providers are scored and ranked and the results provided in a qualified list of providers. (P[0063]). It is inherent in ranking that a highest ranking provider is identified, and therefore a notification of such is generated with the qualified list in P[0063].
36. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a highest ranking, as disclosed by Vashistha, in the system of Das for the motivation of for the motivation of selecting a provider. Ranking is an old and well known form of aiding decision making and Das discloses that the selection may be based on the results of the negotiation, as well as other factors where the lowest price is not necessarily the basis for selection. (Das; P[0080]). By scoring and ranking, as disclosed by Vashistha, these other factors are accorded a role in the automated decision making process of Das.
37. **Claims 8, 16 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Das et al. (US Pub. No. 2003/0023499, hereafter referred to as "Das") in view of Vashistha et al. (US Pub. No. 2001/0051913, hereafter referred to as "Vashistha") in further view of Chun et al. (US Pub. No. 2002/0184527, hereafter referred to as "Chun").
38. **Claims 8, 16 and 24:** Das/Vashistha discloses the limitations of claims 7, 15 and 23. Das discloses evaluating vendors to identify a set of vendors from which a service can be obtained. (Abstract). Das does not disclose payroll management, employee, payment or banking information.

39. Chun, however, discloses that businesses outsource payroll management (P[0004]) that includes the exchange of data relating to human resources and payroll. (P[0025]). Data and information relating to employees, salaries (i.e., payment) and banking are inherently comprised in the data disclosed.
40. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included payroll management and data, as disclosed by Chun, in the system of Das for the motivation of providing an example of a service providing vendor.

Response to Arguments

41. Applicant's arguments filed July 24, 2008 regarding the prior art rejections have been fully considered but are not persuasive. Das et al. discloses both service descriptors such as pricing and availability (P[0050]) and the ranking of satisfactory service providers based on service descriptors (P[0047]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629